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Fax Cover Sheet

DATE: November 20, 2002

FROM: Charles E. Bell, Esq.
Direct Dial 617 210 6830
cebell@mintz.com

To:

NAME	COMPANY	BUSINESS #	FAX #
W. Gary Jones Supervisory Patent Examiner Technology Center 1600	U.S. PTO	(703) 308-1152	(703) 746-5111

MESSAGE:

Dear Examiner Jones:

Further to our telephone conversation earlier today regarding U.S.S.N. 09/614,505 (Attorney Docket No. 15966-539 CIP) and the Notice of Non-Responsive Amendment issued therein, please find attached a copy of a Request for Reconsideration of the Notice and entry of the amendment, a copy of the Notice, and a certificate of facsimile transmission for same. Please do not hesitate to contact me with any questions.

Sincerely,
Charles E. Bell

TRA 1735870v1

We are sending a total of 6 pages, including this cover sheet.

Please call us at 617.348.4966, if you experience any problems.

STATEMENT OF CONFIDENTIALITY
THE INFORMATION CONTAINED IN THIS FAX IS INTENDED FOR THE EXCLUSIVE USE OF THE ADDRESSEE AND MAY CONTAIN CONFIDENTIAL OR PRIVILEGED INFORMATION. IF YOU ARE NOT THE INTENDED RECIPIENT, YOU ARE HEREBY NOTIFIED THAT ANY FORM OR DISSEMINATION OF THIS COMMUNICATION IS STRICTLY PROHIBITED. IF THIS FAX WAS SENT IN ERROR, PLEASE IMMEDIATELY NOTIFY US BY PHONE.

VIA FACSIMILE

Attorney Docket No. 15966-539 CIP (Cura-39 CIP)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT(S): Rothberg *et al.*
SERIAL NO.: 09/614,505 EXAMINER: Monika B. Scheinberg
FILING DATE: July 11, 2000 ART UNIT: 1634
FOR: Method for Identifying a Biomolecule

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence, and any documents referred to as attached hereto, is/are being transmitted to W. Gary Jones, Supervisory Examiner for Technology Center 1600 of the United States Patent and Trademark Office, Facsimile Number: (703) 746-5111 on this 20th day of November, 2002.

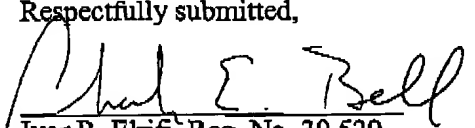

Charles E. Bell

Transmitted herewith for filing in the above-referenced application are the following documents:

- Request for Reconsideration of Notice of Non-Responsive Amendment (1 pg.); and
- Copy of the Notice (3 pgs.).

Applicants believe that no fee is due in connection with this submission. However, the Commissioner is hereby authorized to charge any fees that may be due to Deposit Account No. 50-0311, Reference No. 15966-539 CIP (Cura-39 CIP).

Respectfully submitted,


Ivor R. Elrifi, Reg. No. 39,529
Charles E. Bell, Reg. No. 48, 128
Attorneys for Applicants
c/o MINTZ, LEVIN
One Financial Center
Boston, Massachusetts 02111
Tel: (617) 542-6000
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Dated: November 20, 2002

TRA 1735809v1

11/20/2002 17:54 FAX 617 542 2241

MINTZ LEVIN

003

VIA FACSIMILE

Date of Transmission: November 20, 2002

Official
11/21/02
Attorney Docket No. 15966-539 CIP (Cura-39 CIP)

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT(S): Rothberg *et al.*
SERIAL NO.: 09/614,505
FILING DATE: July 11, 2000
FOR: Method for Identifying a Biomolecule
EXAMINER: Monika B. Scheinberg
ART UNIT: 1634

Commissioner for Patents
Washington, D.C. 20231
Attn: Exr. Gary Jones
Technology Center 1600

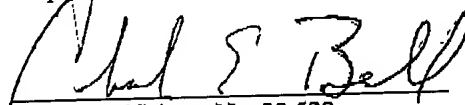
REQUEST FOR RECONSIDERATION OF NOTICE OF NON-RESPONSIVE AMENDMENT

In response to the Notice of Non-Responsive Amendment mailed November 11, 2002, in the above-identified application, Applicants respectfully request reconsideration and entry of the amendments filed in an RCE on October 8, 2002.

Applicants submit that previously pending claims 27, 43, and 55 were combined to arrive at the new independent claims 58, 72, and 73. New claims 59-71, and 74-90 depend, directly or indirectly, from claim 58. Therefore, claims 58-90 are not directed to a non-elected invention and it is respectfully requested that they be entered for further consideration.

A response to this Notice is due on or before December 6, 2002. Applicants believe that no fee is due in connection with this submission. However, the Commissioner is hereby authorized to charge any fees that may be due to Deposit Account No. 50-0311, Reference No. 15966-539 CIP (Cura-39 CIP).

Respectfully submitted,



Ivor R. Elrifi, Reg. No. 39,529

Charles E. Bell, Reg. No. 48, 128

Attorneys for Applicants

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Dated: November 20, 2002

TRA 1735846v1



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/614,505	07/11/2000	Jonathan M. Rothberg	15966-539-CIP(CURA-39CIP)	2086

30623 7590 11/06/2002

MINTZ, LEVIN, COHN, FERRIS, GLOVSKY
AND POPEO, P.C.
ONE FINANCIAL CENTER
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Done By	
<input type="checkbox"/> Data Entry	
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EXAMINER	
SHEINBERG, MONIKA B	
ART UNIT	PAPER NUMBER

1634

DATE MAILED: 11/06/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

RECEIVED
NOV 11 2002
MINTZ LEVIN, BOSTON
PATENT DOCKET DEPT


**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: ASSISTANT COMMISSIONER FOR PATENTS

Washington, D.C. 20231

APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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EXAMINER

ART UNIT PAPER

24

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Notice of Non-Responsive Amendment

The amendment filed on 08 October 2002 canceling all claims drawn to the elected invention and presenting new claims 58-90, drawn to a non-elected invention is non-responsive (MPEP § 821.03). The new claims are not readable on the elected invention because the method steps of the new claims are different and distinct from the originally elected claims. Newly submitted claims 58-90 are directed to an invention that is independent or distinct from the invention originally claimed for the following different and distinct steps of methodology: digestion and partitioning of one or more populations of nucleic acid molecules prior to library construction of each portioned population [see steps (b)-(d)], followed by the pooling of select specific fragments from the library, further partitioning, and mapping [see steps (e), (f) and (g)]; while the cancelled original claim 27 separates, isolates and constructs a library of a one set of nuclei acid molecules [see steps (b)-(d)]; followed by the recovery of non-specific nucleic acids, separation of a subset and isolation [see steps (e), (f) and (g)]. Therefore the method steps of the new claims have a different and distinct order of methodology than those of the cancelled original claims.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 58-90 have been withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Since the above-mentioned amendment appears to be a *bona fide* attempt to reply, applicant is given a TIME PERIOD of ONE (1) MONTH or THIRTY (30) DAYS, whichever is longer, from the mailing date of this notice within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD UNDER 37 CFR 1.136(a) ARE AVAILABLE.

Inquiries

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CFR § 1.6(d)). The CM1 Fax Center number is (703) 308-4242.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monika B. Sheinberg, whose telephone number is (703) 306-0511. The examiner can normally be reached on Monday-Friday from 1 P.M. to 8 P.M. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones, can be reached on (703) 308-1152.

~90C (Rev.3-98)

Received from < 617 542 2241 > at 11/20/02 5:55:21 PM [Eastern Standard Time]

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Patent Analyst, Chantae Dessau, whose telephone number is (703) 605-1237, or to the Technical Center receptionist whose telephone number is (703) 308-0196.

October 30, 2002
Monika B. Sheinberg
AU 1634

MBS


W. Gary Jones
Supervisory Patent Examiner
Technology Center 1600